

REMARKS

Claims 1-27 are pending in the present application. Independent claims 1 and 17 have been amended. No new subject matter has been added. Support for the amendments may be found between line 16 on page 9 and line 11 on page 10 of the Patent Application.

In the Office Action, claims 1 and 17 were rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Tiedemann et al (U.S. Patent No. 6,982,971) in view of Park et al (U.S. Pub.2002/0045448). Claims 2-13 and 18-25 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Tiedemann in view of Park in further view of Blackeney II et al (U.S. Patent No. 5,267,261). Claims 14, 15, 26, and 27 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Tiedemann in view of Blackeney. Claim 16 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Tiedemann in view of Blackeney further in view of Sekine et al (U.S. Pub. No. 2001/0024429). The Examiner's rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Moreover, the differences between the prior art and the subject matter to be patented as a whole must not have been obvious to at the time of invention to a person of ordinary skill in the art. 35 U.S.C. § 103(a). For the Examiner's rejection to be proper, the cited references must teach the claimed features exactly.

Amended claim 1 teaches a method for synchronizing signals associated with multiple asynchronous base stations during soft hand-off. The Examiner suggests that Tiedemann teaches the features of claim 1. *See* Office Action (09-11-07), p.3. Specifically, the Examiner argues that Tiedemann discloses that a mobile device establishes a link with a first and second base station using a frame offset, communicating with the first and second base stations during

handoff using the same frame offset, and communicating with the second base station using adjusted reverse link demodulation timing after the handoff. *See id.*; *see also* Tiedemann, cols. 10-11. A close reading of Tiedemann, however, reveals that this reference is concerned with synchronization involving *synchronous* base stations, not asynchronous-to-asynchronous base station synchronization, as called for in claim 1 of the instant Application. Because Tiedemann calls for a base station with a known timing reference point, it is unnecessary to transmit any synchronization signals regarding the base station (*i.e.*, the base station in Tiedemann is already synchronized). As such, Tiedemann cannot teach synchronizing signals associated with multiple asynchronous base stations during soft hand-off, as set forth in claim 1.

Additionally, the Examiner relies on passages in Tiedemann that disclose only synchronous-to-synchronous base station interactions, wherein the two base stations share a common time reference. *See* Tiedemann, cols. 10-11. Thus, the base stations use a common frame offset. In contrast, claim 1 calls for asynchronous base stations where such frame offset values are non-availing. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986). In the instant Application, it is clear that Tiedemann only discloses synchronization involving a synchronous base station, therefore Tiedemann teaches away from the instant Application.

Moreover, it is also well established that where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination. *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984). That is, if the proposed combination undermines the purpose of the prior art, it cannot be obvious. Here, the Examiner proposes modifying Tiedemann with the teachings of Park that

would defeat the purpose taught in Tiedemann. Tiedemann requires a synchronous base station, while Park is concerned with asynchronous wireless telecommunication systems.

In view of at least the aforementioned reasons, claim 1 and its dependent claims are allowable. For similar reasons, claim 17 and its respective dependent claims are also allowable.

Other pending claims are also allowable for features recited therein. For example, independent claim 17 calls, in part, for retaining the first synchronizing signal in memory of said at least one second base station for later synchronizing communications between the mobile unit and at least one of the first base station and the at least one second base station. The Examiner admits that Tiedemann in view of Blackeney fails to teach the “retaining” feature. However, the Examiner suggests that Sekine remedies the deficiencies of Tiedemann in view of Blackeney. Applicant respectfully disagrees.

Sekine, cited at ¶¶[0069-0073], describes the communication of a synchronizing signal, but is *completely silent* regarding storage of the signal information. Sekine shows that the second base station **104** receives, via input into its assembler/offset corrector **306**, offset information from base station **103**. The assembler/offset corrector **306** uses the received input to calculate the offset of base station **104**. Sekine, ¶[0073], and Figs. 6 & 7. Sekine is silent regarding a memory for the information storage, and Applicant submits that the offset calculation presented is a real-time operation not stored or used later by the base station **104**. Sekine, Fig. 8. In contrast, the instant Application teaches retaining the first synchronizing signal in memory of said at least one second base station for later synchronizing communications between the mobile unit and at least one of the first base station and the at least one second base station. The Radio Network Controller **138** provides timing information to Node B **130**, and Node B **130** then stores the information in memory where it may be quickly recalled for later hand off operations. *See* Application, page 9, line 16 to page 10, line 11.

Additionally, Sekine fails to provide a suggestion or motivation for storing synchronized signal information in the memory of a base station. The Sekine publication is completely silent regarding *any* storage in base stations, and Sekine fails to raise issues or problems about the storage of synchronized signal information in base station memory.

For at least the aforementioned reasons, Applicant respectfully submits that claim 17, and its dependent claims, are allowable. For reasons similar to those of claim 17, claim 16 is also allowable.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-7000 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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